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Bethards@bethardslaw.com**FACSIMILE TRANSMISSION****Date:** 11/7/2005**Pages:** 12 w. cover**To:** Examiner Joseph E. Avellino**From:** Charles W. Bethards**Company:** USPTO, Art Unit 2143**Fax No.:** 571-273-8300**Subject:** Response to September 8, 20005 Advisory Action: App. Serial No. 10/045,724

- Transmittal form
- Extension of time request
- Fee transmittal
- Credit card authorization
- Notice of Appeal
- Pre-Appeal Brief request for review with accompanying arguments (6 pages)

Applicant(s): Huddleston, et al Serial No.: 10/045,724 Filed: October 26, 2001 Title: METHOD AND APPARATUS FOR BROKERING OF CONTROL INSTRUCTIONS FOR AN INTELLIGENT DEVICE	Atty. Dkt.: PF02200NA/10-31 Group Art Unit: 2143 Examiner: Joseph E. Avellino
CERTIFICATE OF FACSIMILE TRANSMISSION under 37 CFR 1.8 I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, Fax No. 571-273-8300 on November 7, 2005 to the attention of Examiner Joseph E. Avellino of AU 2143. Typed Name: Charles W. Bethards Signature: <i>Charles W. Bethards</i>	

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/045,724
	Filing Date	October 28, 2001
	First Named Inventor	Wayne Allen Huddleston et al
	Art Unit	2143
	Examiner Name	Joseph E. Avellino
	Attorney Docket Number	PF02200NA/10-31
Total Number of Pages in This Submission		11

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Credit card authorization form; pre Appeal brief review request with accompanying arguments.
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Charles W. Bethards, Reg. No. 36,453		
Signature			
Date			

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Typed or printed name	Charles W. Bethards		
Signature	<i>Charles W. Bethards</i>	Date	November 7, 2005

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FEE TRANSMITTAL for FY 2005

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant Claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ **620.00**)

Complete if Known

Application Number	10/045,724
Filing Date	October 26, 2001
First Named Inventor	Wayne Allen Huddleston et al
Examiner Name	Joseph E. Avellino
Art Unit	2143
Attorney Docket No.	PF02200NA/10-31

METHOD OF PAYMENT (check all that apply)

☐ Check ☒ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account

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Deposit Account Name
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FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1001	790	2001	395	Utility filing fee	
1002	350	2002	175	Design filing fee	
1003	550	2003	275	Plant filing fee	
1004	790	2004	395	Reissue filing fee	
1005	180	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$ **0**)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims Independent Claims	Extra Claims	Fee from below	Fee Paid
-20*-	<input type="checkbox"/> X	50	
-3*-	<input type="checkbox"/> X	200	
Multiple Dependent		360	

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1202	50	2202	25	Claims in excess of 20	
1201	200	2201	100	Independent claims in excess of 3	
1203	360	2203	180	Multiple dependent claim, if not paid	
1204	200	2204	100	**Reissue independent claims over original patent	
1205	50	2205	25	**Reissue claims in excess of 20 and over original patent	

SUBTOTAL (2) (\$ **0**)

* or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee (\$)	Small Entity Fee Code	Small Entity Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,820	1812	2,820	For filing a request for ex parte reexamination	
1804	820*	1804	820*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	120	2251	60	Extension for reply within first month	\$120.00
1252	450	2252	225	Extension for reply within second month	
1253	1,020	2253	510	Extension for reply within third month	
1254	1,500	2254	795	Extension for reply within fourth month	
1255	2,160	2255	1,080	Extension for reply within fifth month	
1401	500	2401	250	Notice of Appeal	500.00
1402	500	2402	250	Filing a brief in support of an appeal	
1403	1,000	2403	500	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	500	2452	250	Petition to revive - unavoidable	
1453	1,500	2453	750	Petition to revive - unintentional	
1501	1,400	2501	700	Utility issue fee (or reissue)	
1602	800	2502	400	Design issue fee	
1603	1,100	2503	550	Plant issue fee	
1480	130	1480	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	790	2809	395	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	790	2810	395	For each additional invention to be examined (37 CFR 1.129(b))	
1801	790	2801	395	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ **620.00**)

SUBMITTED BY

Name (Print/Type)	Charles W. Bethards	Registration No. (Attorney/Agent)	36,453	Telephone	(817) 581-7005
Signature	Charles W. Bethards			Date	11/07/05

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) PF02200NA/10-31
I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office Fax No. 571-273-8300 on November 7, 2005 to the attention of Examiner Joseph E. Avellino of AU 2143.		
Typed Name: <u>Charles W. Bethards</u>	Application No. 10/045,724	Filed October 26, 2001
Signature: <u>Charles W. Bethards</u>	First Named Inventor: Wayne Allen Huddleston et al	
	Art Unit: 2143	Examiner Joseph E. Avellino
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reasons stated on the attached sheets(s). <u>Five (5) pages attached</u> Note: No more than five(5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record the entire interest.</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>36,453</u></p> <p><input type="checkbox"/> attorney or agent under 37 CFR 1.34(a). Registration number if under 37 CFR 1.34(a). _____</p> <p><u>Charles W. Bethards</u> Signature <u>Charles W. Bethards (Reg. No. 36,453)</u> Typed or printed name <u>817-581-7005</u> Telephone Number <u>November 7, 2005</u> Date</p>		

PRE APPEAL BRIEF REQUEST FOR REVIEW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/045,724 Applicant: Huddleston, et al Filed: October 26, 2001
Examiner: Joseph E. Avellino TC/A.U.: 2143 Docket No.: PF02200NA/10-31

Accompanying Arguments/Discussion

History: The present application was filed on October 26, 2001. On or about February 9, 2005 a first Office Action was mailed that rejected all claims. An Amendment and Response was filed on or about June 9, 2005 wherein claim 18 was amended to clarify the claim language and arguments were advanced seeking to traverse the Examiner's claim rejections. On July 7, 2005 a Final Office action was mailed that maintained the original rejections of all 20 claims. An Examiner Interview was conducted on August 31, 2005 with an Interview summary mailed on September 8, 2005. An After Final response was filed on September 2, 2005 and on September 30, 2005 an Advisory Action was mailed, which indicated that the arguments presented in the After Final Response were not persuasive.

Status and this Response: Claims 1-20 are pending and stand rejected on varying grounds under §102(b) and 103(a). No claims are being amended, canceled, or added and no other papers are pending. In view of the comments below, Applicant respectfully submits that the rejections have been traversed and thus requests that the Panel reconsider the present application including claims 1-20 and withdraw the rejection of these claims.

a) Claims 1, 2, 5, 8, 9, 11-12, 15, and 17-20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Tessler et al (U.S. Patent No. 5,629,868).

Claims 1, 11, and 18 are in independent form with all other claims dependent on the closest lower numbered independent claim. As noted in the June 9, 2005 response, the present invention deals with various aspects of obtaining appropriate commands from a web site for effecting a desired function by an intelligent device. It is noted that Applicant is not claiming all approaches for programming a remote control; rather only those methods and apparatus of obtaining commands for an intelligent device as specifically defined by the claims. Claim 1 defines a method that includes defining in a wireless internet access device (WIAD) a desired function to be performed by the intelligent device, identifying via the WIAD the intelligent device and desired function to a web site through a wireless communication network, returning to the WIAD from the web site a subset of control instructions for controlling the intelligent device to perform the desired function and forwarding the subset of control instructions to the intelligent device all as specifically claimed.

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Accompanying arguments, Pre-App Brief Request, filed November 7, 2005

Tessler et al. concerns programming a remote control with appropriate data to control a selected appliance and may be viewed as related art. The Panel is referred to page 3 second paragraph of the September 2, 2005 §116 Response for a more detailed characterization of Tessler et al. In summary, Tessler et al. discusses a TV remote control 39 that accesses, via an IR link, a subscriber station 38 (set top box) to obtain commands from the stations memory to control an appliance (VCR). The subscriber station obtains the commands from a cable TV head end 3, by selecting sets of control data as they are broadcast.

Issue: Whether Tessler et al. anticipates the wireless internet access device and functional features thereof as recited by claim 1.

The Examiner in the July 7, 2005 Final Office action construes the TV remote control as a wireless internet access device and the subscriber station as a web site, citing col. 2, lines 36-50. [Note in the Advisory Action of September 30, 2005 the Examiner states that the Subscriber station reads on the WIAD?] In Applicant's view this is not a proper construction of these entities. Nothing in Tessler et al. ever mentions or otherwise suggests that the TV remote control 39 is an internet or web access device and similarly nothing suggests that the subscriber station or terminal could or would ever be reasonably construed as a web site. The Panel is referred to the September 2, 2005 §116 Response for a more detailed discussion. Generally the Examiner believes that the TV remote control of Tessler et al may be viewed as the claimed wireless internet access device (WIAD) based on the Examiner's view that "wireless internet access" should be interpreted as a mere label and that somehow Applicant is reading something from the specification into the claim.

Applicant respectfully disagrees in this instance as claim 1 clearly specifies defining in a WIAD desired functions for an intelligent device and identifying via the WIAD and a wireless network the function and device to a web site and returning from the web site corresponding control instructions to the WIAD. Given a wireless internet access device and claimed interaction with a web site and that web sites are those entities accessed via the Internet or Web by such devices, as clearly appreciated by those of ordinary skill, Applicant respectfully submits that "wireless internet access" should as intended by the Applicant be given the consideration that the claim language requires and that this corresponds to what one of ordinary skill would give the term. Basically claim 1 includes accessing the Internet via the WIAD since web sites are accessed via the Internet and Tessler et al does not show or suggest the corresponding features of claim 1. The Examiner admits in the advisory action that Tessler et al does not show or suggest

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Accompanying arguments, Pre-App Brief Request, filed November 7, 2005

internet access by suggesting that adding an explicit reference to access via the Internet to the identifying feature of claim 1 would differentiate claim 1 from Tessler et al. While Applicant could specify that the wireless internet access device is configured to wirelessly access the internet and further that the identifying ... to a web site includes internet access this seems unnecessarily pedantic and obfuscating. This is contrary to the policy of being clear as to what is claimed and might result in Applicant giving up Equivalent Patent rights in view of *Festo* and progeny. This is clearly not appropriate under the present circumstances. Thus and in view of these reasons, Applicant respectfully submits that the elements of claim 1 that recite performance of a process by a WIAD are not shown or suggested by Tessler et al.

Issue: Whether Tessler et al. anticipates the web site and functional features thereof as recited by claim 1? The Examiner maintains that the subscriber station of Tessler et al. is the claimed web site and that Applicant is reading limitations into the claim from the specification. Applicant disagrees and specifically assures the Examiner and Panel that Applicant is merely reading and construing the claim. The claim specifies that a web site is accessed and returns control instructions to the WIAD. Tessler et al. does not show or suggest a web site or access thereto as claimed, given any reasonable construction. The Examiner in the Advisory Action of September 30, 2005 maintains that Applicant intended the web site to function solely as a data server. Applicant is not sure how the Examiner could be so sure about Applicant's intentions, however it is clear that Applicant's claims are limited to a web site and the claimed functionality/interaction thereof. The Panel is referred to the September 2, 2005 §116 Response beginning with the Issue near the bottom of page 5 and continuing through page 6 for a more detailed discussion.

Applicant strongly disagrees with the Examiner's suggestion that a server = a web site and submits that one of ordinary skill would not construe just any server as being a website, simply because as the name has come to imply the server provides data to another entity. There are many examples of servers that provide data that are clearly not web sites. Thus and in view of these reasons, Applicant respectfully submits that the subscriber station, notwithstanding having down stream access to a cable TV head end via reception of broadcast information and ability to forward this information to a TV remote control, is not and is not susceptible to being reasonably construed as a web site.

Issue: Whether Tessler et al. anticipates the defining, in a wireless internet access device, a desired function to be performed by the intelligent device and functional relationships thereof as

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Accompanying arguments, Pre-App Brief Request, filed November 7, 2005

recited by claim 1. With respect to Applicant's view that Tessler et al. does not anticipate the claimed defining process, the Examiner states:

"Applicant's attention is requested [??] to Tessler, col. 2 lines 40-45. Applicant will find out that the subscriber (i.e. the user) selects whichever is of interest from the list and then *transmits the teach code to the subscriber station*. To one of ordinary skill in the art, this clearly shows the step of defining a desired function to be performed by the intelligent device. By this rationale, the rejection is maintained."

In Applicant's view sending a teach code that corresponds to a particular appliance from the remote control to the subscriber station does not anticipate defining in a WIAD a desired function to be performed by the intelligent device. The remote control has no idea of what functions will be controllable as a result of this activity, although I suppose the user would expect that control of ON/OFF and other expected functions of the selected appliance would be provided.

Issue: Whether Tessler et al. anticipates the identifying the intelligent device and the desired function to a web site ... by the WIAD, through a wireless communication network and functional relationships thereof as recited by claim 1.

The Panel is referred to the Issue at the bottom of page 7 and the ensuing discussion on page 8-9 for a detailed discussion. Generally the Examiner is viewing the IR link of Tessler et al. as a wireless communication network. Applicant submits that those of ordinary skill would not view an IR link as a wireless communication network as a network is viewed as interconnected facilities suitable for supporting a plurality of wireless paths.

Regarding independent claim 11 and as noted in the June 9, 2005 response, claim 11 defines a WIAD that interacts via a wireless communication network with a web site to identify an intelligent device and desired functionality and thus obtain an appropriate response with control instructions from the web site all as claimed. As noted earlier the system of Tessler et al. and specifically the remote control and the subscriber station are clearly not a WIAD or web site, respectively and thus Tessler et al. does not show or suggest the claimed WIAD.

As noted in the June 9, 2005 response with reference to claim 18 a web site is defined that interfaces with a WIAD via a wireless communication network to facilitate providing appropriate commands to control an intelligent device. Tessler et al. does not show or suggest any such WIAD or web site and the subscriber device of Tessler et al. is not subject in good faith to being construed as a web site. Furthermore any interaction between the remote control and subscriber station is not via a wireless communication network, but rather via an IR link.

Appl. No. 10/054,724

Accompanying arguments, Pre-App Brief Request, filed November 7, 2005

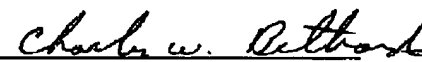
For at least one or more of the reasons noted above, all elements of the claimed inventions are not shown or suggested by Tessler et al., and thus this reference does not support a 102(b) rejection of independent claims 1, or 11, or 18 or, at least by virtue of dependency, claims that are respectively dependent thereon. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1, 2, 5, 8, 9, 11-12, 15 and 17-20 under 35 U.S.C. 102(b) based on Tessler et al (USPN 5,629,868).

b) Claims 3, 4, 6, 7, 13, 14, and 16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Tessler et in view of Maymudes (U.S. Patent No. 6,748,278). Claim 10 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Tessler et al. in view of Baun et al (U.S. Pub. No. 2003/0197930). As noted in the June 9, 2005 response, Claims 3, 4, 6, 7 and 10 are dependent on claim 1 and claims 13, 14, and 16 are dependent on claim 11. Maymudes or Baun et al. do not supply the teachings that are believed to be missing from Tessler et al and thus claims 1 and 11 are believed to be allowable over these combinations of references whether taken alone or together. Thus at least by virtue of dependency claims 3, 4, 6, 7, 10, 13, 14, and 16 should also be allowable. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 3, 4, 6, 7, 13, 14, and 16 under 35 U.S.C. 103(a) based on Tessler et al. in view of Maymudes (USPN 6,748,278) and the rejection of claim 10 under 35 U.S.C. 103(a) based on Tessler in view of Baum et al (US 2003/0197930).

Accordingly, Applicant respectfully submits that the claims clearly and patentably distinguish over the cited references of record and as such are to be deemed allowable. Although it is not anticipated that any fees are due or payable other than the separately noted Notice of Appeal and Petition for one month extension fee, the Commissioner is hereby authorized to charge any fees that may be required to Deposit Account No. 50-3435.

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Respectfully submitted,


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